

Application No.: 10/724,406
Amendment dated: April 5, 2006
Reply to Office Action: October 5, 2005



REMARKS

This Amendment is responsive to the office action dated October 5, 2005. Claims 17-46 are pending and stand rejected. Also the office action indicated that the information disclosure statement filed on August 23, 2005, fails to fully comply with the 37 CFR 1.98(a)(2). Applicant respectfully submits that an information disclosure statement and forms PTO-1449 are contemporaneously filed with this amendment. With the information disclosure statement, copies of all the foreign patents and articles are also submitted. Consideration of these documents is respectfully submitted.

In paragraph 2 of the office action, the Examiner rejects claims 17-46, indicating that claims 17, 20, 22, 32, and 35 recite "vendor data sites," for which there is no description in the specification. Applicant respectfully submits that Figure 1 shows vendor terminals L1-Ln. By way of one example, at page 15, paragraph 0051, the specification describes that the "vendors may have desktop personal computers incorporating live-action, color video with standard voice telephone lines via networks and modems." Clearly, the video just by itself would constitute data stored on a desktop personal computer. Furthermore, at page 19, paragraph 0062, the specification indicates that "central traffic control system TIS directs and exchanges on-line and off-line traffic between the vendor and buyer sites..." Moreover, the terminology "vendor locations" is liberally referenced throughout the specification. Applicant respectfully submits that the terminology used in the claims is well-supported by his specification and requests the Examiner to either withdraw the rejection under 35 U.S.C. Section 112.

With respect to claim 32, the Examiner notes that it recites the step of "receiving and storing indications of the consummation of a transaction between a vendor terminal and an active buyer terminal." However, the Examiner takes the position that the specification does not describe any receipt or storage of indications of consummation of a transaction. The Examiner views the system described as enabling communication between vendors and buyers during which a sale can be consummated. The Examiner takes the position that there is no data stored regarding a consummated transaction. Applicant is puzzled by the Examiner's reasoning. The system described clearly enables communication between vendors and buyers during which a

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sale is consummated. The system has data storage capabilities and illustrates in many examples that data relating to the communications is stored, which would logically include data relating to any sale consummated during the communications. By way of one example, at page 40, the specification indicates that in routine situations, the buyer and vendor is associated with specific merchandise codes, which not only facilitate and expedite communication, but additionally, charges and billing data (for storage in the memory T30) may be based on active merchandise codes for a subscriber. The specification describes keeping logs and records of all communications between vendors and buyers including any sales that are consummated. Applicant respectfully requests the Examiner to withdraw the rejection of claim 32 for the reasons urged above.

Applicant submits that the specification teaches printing data relating to all buyer vendor communications, which would include data on any transactions that are consummated. Nevertheless, Applicant has amended the claim by deleting the reference to "accomplished."

In paragraph 5, the Examiner rejected claims 17-27, 29-42, and 44-46 under 35 U.S.C. Section 103(a) as unpatentable over Shavit et al in view of Lockwood. The Examiner alleges that Shavit differs from claims 17, 22, 24, 26-27, and 29 only in that it does not selectively provide video data for display by an active buyer terminal in accordance with types of merchandise and/or services relating to areas of interest. However, the Examiner further alleges that Lockwood teaches the desirability of having a central processor select an appropriate vendor-supplied data source associated with the customer's request, for output to the customer as a high-resolution audio-visual presentation such that it would have been obvious to one of ordinary skill to provide such selective video data provision as taught by Lockwood, within the system of Shavit in order to enhance sales communication by providing buyers with a video image of the merchandise and a more efficient means of selecting goods and services from a plurality of vendors by providing customized audio/video presentations based on the buyer's area of interest. Applicant respectfully submits that if Shavit does not even disclose provision of any

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video data in the context of the claimed invention, any teaching of selective video data provision in Lockwood is not without hindsight. To that end, Applicant respectfully requests the Examiner to reconsider the rejections based on such a combination. Applicant respectfully submits that the Examiner's rejection for obviousness is improper because there is no recitation in the cited prior art references, either singly or in combination, to suggest the desirability of the claimed subject matter. That the construction in a particular prior art reference would have resulted in the claimed combination had it followed the "common practice" of attaching certain parts does not show obviousness at the time of the invention but rather reflects improper hindsight analysis and the reading into the art of Applicant's own teachings.

In re Raynes, 7 F.3d 1037, 1039 (Fed. Cir. 1993):

When determining whether a new combination of known elements would have been obvious in terms of 35 U.S.C. § 103, the analytic focus is upon the state of knowledge at the time the invention was made. The Commissioner bears the burden of showing that such knowledge provided some teaching, suggestion, or motivation to make the particular combination that was made by the applicant. *In re Oetiker*, 977 F.2d 1443, 1445-47, 24 U.S.P.Q.2D (BNA) 1443, 1444-46 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. (BNA) 785, 788 (Fed. Cir. 1984). This determination is made from the viewpoint of the hypothetical person of ordinary skill in the field of the invention. 35 U.S.C. § 103; *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991).

In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986):

"There was no suggestion in the prior art to provide Deminski with the motivation to design the valve assembly so that it would be removable as a unit. The board argues that if Pocock had followed the "common practice" of attaching the valve stem to the valve structure, then the valve assembly would be removable as a unit. The only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made." 35 U.S.C. § 103 (1982); *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 585, 160 U.S.P.Q. (BNA) 237, 243 (CCPA 1969)."

Regarding claims 18-19 and 21, the Examiner takes Official Notice that merchandise are known to be identified by a product code such that it would have been obvious to one of ordinary skill to incorporate such a product code within the combination of Shavit and Lockwood.

Applicant respectfully traverses such Official Notice. It would not have been so obvious to use

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product codes within the combination of Shavit and Lockwood. The combination of Shavit and Lockwood is not so obvious for the reasons demonstrated above, much less, with product codes etc. to ease otherwise complex commercial transactions.

The other claims are distinct at least for the same reasons demonstrated with respect to the independent claims from which they depend. Specifically, with respect to claims 28 and 43, the Examiner has further relied on Kaye in combination with Shavit and Lockwood to argue that the claimed invention is obvious. Applicant respectfully submits that the need for yet another reference simply demonstrates that the claimed invention was not so obvious.

Reconsideration of this application and allowance of the claims as presented here is respectfully requested.

Respectfully submitted,

Dated: April 5, 2006

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